

REMARKS

Claims 1-29 are pending in this application. Applicants have elected, with traverse, the claims of Group I, claims 1-3, 7-16, and 29, drawn to a combination product comprising an antisense targeted against MBD2 demethylase and an agent used in antitumor chemotherapy for treatment of proliferative and inflammatory diseases. Claims 4-6, and 17-28 and SEQ ID NO:2 have been canceled as being directed to non-elected subject matter. Claim 30 is added. No new matter has been added with this Amendment. With entry of this Amendment, claims 1-3, 7-16, 29 and 30 pertaining to SEQ ID NO:1 will be pending for consideration.

I. In the Specification

The disclosure is objected to because of the following informalities: This application contains Drawings (Figures 1&2) that require brief description of drawings in the specification. See MPEP §608.01 and 37 CFR 1.74.

In response, applicants have added a description to the Figures based on the descriptions in Examples 1 and 2. No new matter is added with this amendment.

II. Claim Objections

Claim 2 is objected to for containing non-elected subject matter. In response, applicants have amended claim 2.

Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

According to the examiner, it is unclear whether the recited "bleomycin" in line 2 of claim 16 is distinct from the recited "compound belonging to the bleomycin family" in lines 2-3 of claim 3, because the instant specification does not disclose any members of bleomycin family except for bleomycin. Applicants traverse this rejection.

In further response, applicants direct the examiner's attention to page 7, lines 25-59 of the English translation submitted herewith, where the "bleomycin family" of compounds is discussed. Thus, claim 16 is a proper dependent claim.

In view of the above amendment and explanation, withdrawal of the objections is respectfully requested.

III. Claim Rejections - 35 USC § 112

The examiner rejects claims 1-3, 7-16, and 29 under 35 U.S.C. 112, first paragraph, for the alleged reason that the specification, while being enabling for a combination product comprising at least one MBD2 antisense oligonucleotide and bleomycin wherein administration of said antisense oligonucleotide occurs 30 minutes after the injection of bleomycin via electrotransfer carrying 500V/cm current for the treatment of proliferative disease, does not reasonably provide enablement for a combination product comprising any other agents or any other routes of antisense administration with any other electric current strengths for the treatment of proliferative and inflammatory diseases. According to the examiner, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Applicants respectfully traverse this rejection on the basis that applicants provide examples falling within the scope of the claims. Although applicants agree that experimentation would be necessary to practice the invention, applicants disagree with the examiner's conclusion that this experimentation is undue. Applicants' discovery of the synergistic combination should not be limited to what is exemplified in the specification. The law does not require that all embodiments covered by the scope of the claims be operable and it was well within the skill of the art at the time of the invention to determine which embodiments would be operable.

Applicants thank the examiner for acknowledging that the invention of new claim 30 is enabled by the specification. Applicants also request the Examiner to reconsider

the rejection of the other claims in view of the English language specification submitted herewith.

Claims 1-3, 7-16, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. According to the examiner, the claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The examiner further states that to provide evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and /or chemical properties, functional characteristics, structure/function correlation, or any combination thereof.

Applicants respectfully traverse this rejection. In fact, applicants do provide structure from which to determine the scope of the claimed genus. Applicants describe the gene encoding MBD2 demethylase. Example 1 provides an example of an antisense oligonucleotide based on this gene, wherein the oligonucleotide has at least 15 consecutive nucleotides of SEQ ID NO:1.

Applicants also respectfully request the examiner to reconsider this rejection in view of the English language specification provided herewith.

The examiner rejects claims 1-3, 7-16, and 29 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner states that the term "prolonged use" in claim 1, line 3 and claim 14, line 2, is a relative term which renders the claim indefinite. Applicants respectfully traverse this rejection. However, in order to advance allowance, applicants have deleted "prolonged" use from claims 1 and 14. Thus, the rejection is moot.

IV. Claim Rejections - 35 USC § 102

Claims 1-3, 7-11, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Szyf et al. (US 2006/0166909 A1).

Applicants respectfully assert that this rejection is rendered moot in view of the verified English translation submitted herewith.

V. Claim Rejections - 35 USC § 103

Claims 1-3, 7-16, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slack et al. (*The Journal of Gene Medicine*, 4:381-389, published online May 17, 2002, applicant's Citation No. A06, Form PTO/SB/08A filed on December 1, 2005), in view of Wang et al. (*Clinical Cancer Research*, 2001, 7:3613-3624).

Applicants respectfully assert that this rejection is rendered moot in view of the verified English translation submitted herewith.

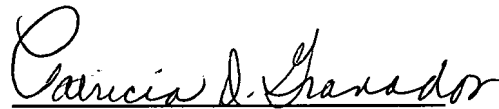
CONCLUSION

In light of the above amendments and comments, Applicants respectfully request that all rejections and objections be withdrawn and that a timely Notice of Allowance be issued in this application. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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